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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,288	12/29/2000	Leroy B. Keely	03797.00071	6510

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EXAMINER

AWAD, AMR A

ART UNIT

PAPER NUMBER

2675

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/750,288	KEELY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Amr Awad	2675	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

***Information Disclosure Statement***

1. The references cited in the information disclosure statement filed April 1/2002 have been considered by the Examiner; see attached PTO-1449.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites "maintained despite re-flowing of said displayed information by a layout engine". This limitation is not clear because the term despite makes not clear whether the re-flowing is carried out or not.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-8 and 14-21 and 27-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Morishita et al. (US patent NO. 6,335,727; hereinafter referred to as Morishita).

As to independent claim 1, Morishita (figures 44A, 44B and 44C) teaches a computer-implemented method for adding electronic ink to displayed information on a system having a display (col. 3, lines 61-67). Morishita teaches classifying the electronic ink (the classifying of the electronic ink is the classifying of first and second mode as shown in figures 44A and 44B) (col. 25, lines 27-41). Morishita teaches associating the electronic ink with at least one object of the displayed information (the association of the electronic ink with at least one object on the display is the searching a written image in a region enclosed within a closed curve as shown in figures 44A and 44B) (col. 25, lines 41-57).

As to claim 2, Morishita teaches that the electronic ink is embedded ink (col. 30, line 64 through col. 31, line 10).

As to claim 3, the claim is broad enough that the width determination of the recorded writing pattern and displayed writing pattern is indicative of determining the distance (col. 24, lines 41-65).

As to claim 4, as discussed above with respect to claim 3, the width determination of the recorded writing pattern and displayed writing pattern is indicative of the ratio of its height to width (col. 24, lines 41-65).

As to claim 5, Morishita teaches anchoring the electronic ink to at least one object (the object would be the circled written image in figure 44A) by adding a link to

the displayed information (the link would be linking to a search region) (col. 25, lines 45-48).

As to claim 6, the closed curve (electronic ink) in figures 44A and 44B for search region is indicative of anchoring the electronic ink to a file position because the search is carried out by searching the memory (col. 25, lines 59-67).

As to claim 7, as can be seen above, the closed curve is near the search region, which is similar to the limitation of claim 7 (col. 25, lines 41-58).

As to claim 8, as best understood by the examiner, Morishita (figures 44A and 44B) shows that the electronic ink (the dashed line by the pen) is maintained despite having other information (re-flowing).

As to claims 14-21, the claims are referring to a computer readable medium, which implements the method of claims 1-8, and as can be seen from Morishita's invention, the device is carried out by a computer readable medium (this is apparent from the flowcharts throughout the drawings of Morishita). Therefore, the rejections of claims 1-8 are equally applied to claims 14-21.

As to claims 27-28, the claims are also similar to claims 1-2 and 14-15 and are rejected as applied to claims 1-12 and 14-15 above.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-13 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morishita in view of Wilcox et al. (US patent NO. 5,889,523; hereinafter referred to as Wilcox).

As to claims 9-13, note the discussion of Morishita above. As can be seen above, Morishita teaches all the limitations of claims 9-13 except the citations of classifying the ink as in-line words, text marks, in-line paragraphs and sketches, margin notes or as a connector.

However, Wilcox (figures 3 and 8-9) teaches a method of entering and editing text in a graphic system (col. 2, lines 16-19). Wilcox shows that the ink used is classified as in-line word, text marks, in-line paragraphs, margin notes or a connector (see figures 3, 8-9, col. 2, lines 16-19, col. 4, line 53 through col. 5, line 11, col. 10, lines 25-33 and col. 11, lines 23-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Wilcox as indicated above to incorporated to Morishita's device because such classifications of the ink is necessary for manipulating and editing a document in handwriting forms as it is necessary in managing and editing a conventional word files to facilitate and ease the work of the user. Furthermore, as motivated by Wilcox, to provide an accurate selection technique for graphical editing (col. 2, lines 20-23).

As to claims 22-26, the claims are substantially similar to claims 9-13 and would be rejected as discussed with respect to the rejections of claims 9-13 above.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reynolds (US patent NO. 6,101,280) teaches a method for compression of electronic ink.

Capps et al. (US patent NO. 5,778,404) teaches a string inserter for pen-based computer systems.

Maxted (US patent NO. 6,340,967) teaches a pen based edit correction interface apparatus.

William et al. (European patent publication NO. EP 1016983 A2) teaches a method and system for maintaining freeform ink annotations on changing views.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amr Awad whose telephone number is (703)308-8485. The examiner can normally be reached on Monday-Friday, between 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Saras can be reached on (703)305-9720. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and (703)872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4750.

A handwritten signature in cursive script, appearing to read "A.A.", is written in black ink.

A.A  
July 13, 2003